

REMARKS

This application has been carefully reviewed in light of the Office Action mailed December 30, 2005. At the time of the Office Action, Claims 1-35 were pending in the application. In the Office Action, the Examiner rejects Claims 1-35. To advance prosecution of this case, Applicants amend Claims 1, 4, 6, 8-9, 11, 13-14, 17, 19, 21, 26, 30, and 34. In addition, Applicants cancel claims 27 and 31. Applicants do not admit that any amendments are necessary due to any prior art or any of the Examiner's rejections. Applicants respectfully request reconsideration and allowance of all pending claims.

Section 112 First Paragraph Rejections

The Examiner rejects Claims 1, 9, 13, and 21 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. In particular, the Examiner states that the specification does not mention a "predetermined frequency range" as recited, in part, in Claims 1, 9, 13, and 21. In the present response, Applicants amend Claims 1, 9, 13, and 21 to recite a "predetermined frequency band." Applicants respectfully submit that the specification provides ample support for this element. In particular, Applicants submit that the specification supports this element on at least page 2 lines 13-20; page 10 lines 3-11; and page 13 lines 13-17.

The Examiner also states that the specification does not mention "receiving a signal" and "generating a data packet corresponding to the signal" as recited, in part, in Claim 13. In the present response, Applicants amend Claim 13 to delete "receiving a signal" and to recite "generating a first data packet and a second data packet." Applicants respectfully submit that the specification provides ample support for this element on at least page 11 lines 14-22; page 12 lines 1-17; and page 15 lines 1-7. For at least these reasons, Applicants respectfully request reconsideration and allowance of amended Claims 1, 9, 13, and 21.

Section 112 Second Paragraph Rejections

The Examiner rejects Claim 13 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, the Examiner states that it is unclear "which

device receives a signal, generates a data packet, and transmits the synchronization and data packets.” (Office Action, pages 2-3). Applicants respectfully traverse this rejection. Amended Claim 13 satisfies the requirements of 35 U.S.C. § 112. In particular, Applicants point out that amended Claim 13 is directed to a method. The statute at issue -- 35 U.S.C. § 112 -- does not require that a method claim recite the entity or device that performs a particular step of the claim. As a result, Applicants respectfully request reconsideration and allowance of amended Claim 13.

Section 103 Rejections

The Examiner rejects Claims 1-24, 26, 27, 29-32 and 34 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,356,945 B1 issued to Shaw, et al. (“*Shaw*”) in view of U.S. Patent No. 6,894,975 B1 issued to Partyka (“*Partyka*”).

The *Shaw-Partyka* combination fails to establish *prima facie* obviousness for at least two reasons. First, the *Shaw-Partyka* combination is improper because the proposed combination would render *Shaw* unsatisfactory for its intended purpose. Second, the proposed combination fails to teach, suggest, or disclose that “the first and second predetermined offsets are usable to determine priority between the first data packet and the second data packet” as recited, in part, in amended Claim 1.

First, the *Shaw-Partyka* combination is improper because the proposed combination would render *Shaw* unsatisfactory for its intended purpose. It is well established that if a “proposed modification would render the prior invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.” MPEP § 2143.01. *Shaw* discloses a set-top assembly that allows different peripheral video devices having different video coding algorithms to communicate with each other. (*Shaw*; col. 2, ll. 11-23). In particular, an operator may connect a television, video camera, personal computer, and other peripheral devices to the set-top assembly. (*Shaw*; col. 1, ll. 13-22). The set-top assembly may then “facilitate real-time formatting” of video content for transmission between the various peripheral devices. (*Shaw*; col. 3, ll. 13-19; col. 4, ll. 21-27). The set-top assembly is able to achieve “real-time” formatting between the peripheral devices that have different coding algorithms by “communicating in multiple

bandwidths” and “automatically adjusting to available bandwidths.” (*Shaw*; col. 1, ll. 53-55; *Shaw*; col. 8, ll. 66-67; col. 9, ll. 1-2). Thus, the set-top assembly in *Shaw* may adjust the communication bandwidth depending on the nature of the transmission and the peripheral devices. (*Shaw*; col. 8, ll. 66-67; col. 9, ll. 1-2) In contrast to the set-top assembly described in *Shaw*, *Partyka* discloses a frequency hopping network. (*Partyka*; col. 6, ll. 21-33). In *Partyka*, “all of the nodes communicate via the same physical channel (i.e., they all use the same frequency, bandwidth and modulation at the same time).” (*Partyka*; col. 6, ll. 49-61). For the nodes in *Partyka* to remain in sync, the nodes are required to “hop” within a constrained bandwidth, regardless of the nature of the transmission. (*Partyka*; col. 6, ll. 49-61). Modifying *Shaw* in view of *Partyka* would result in a set-top assembly that wirelessly communicates with peripheral devices by frequency hopping. For the set-top assembly to remain in sync with the peripheral devices, communication between the set-top assembly and the peripheral devices would be confined to a specified, constrained bandwidth. Limited to a constrained bandwidth, the set-top assembly would be unable to “communicat[e] in multiple bandwidths” and “automatically adjust[] to available bandwidths.” (*Shaw*; col. 1, ll. 53-55; *Shaw*; col. 8, ll. 66-67; col. 9, ll. 1-2). As a result, the set-top assembly would be unable to achieve real-time formatting of video content. (*Shaw*; col. 3, ll. 13-19; col. 4, ll. 21-27). Thus, the proposed combination would render *Shaw* unsatisfactory for its intended purpose. As a result, there is no motivation or suggestion to make the proposed modification. Accordingly, the proposed combination is improper.

For a second reason, the proposed combination would render *Shaw* unsatisfactory for its intended purpose. Specifically, the proposed modification would render some of the peripheral video devices in *Shaw* unable to communicate with the set-top assembly. As explained above, *Partyka* discloses a frequency hopping network comprising a plurality of nodes. (*Partyka*; col. 6, ll. 21-33). Because of the frequency hopping protocol in *Partyka*, a particular node cannot communicate with all of the other nodes directly. (*Partyka*; col. 6, ll. 21-34). In particular, *Partyka* states that “not all of the nodes can communicate with each other directly; only those nodes that are connected by one of paths 111 through 118 can communicate directly. For example, node 105 cannot communicate with node 101 directly, but only indirectly through other nodes.” (*Partyka*; col. 6, ll. 21-34). In contrast to *Partyka*,

Shaw discloses a system wherein all of the peripheral devices communicate directly with the set-top assembly. (Fig. 1). Indeed, the set-top assembly is intended to control all of the peripheral devices. (*Shaw*; col. 3, ll. 12-20). Modifying *Shaw* in view of *Partyka* would result in a system wherein some of the peripheral devices would be unable to directly communicate with the set-top assembly. Instead, a particular peripheral device would be required to indirectly communicate with the set-top assembly via another peripheral device. Such a system would be inoperable because the two peripheral video devices have “incompatible” video coding algorithms and would be unable to communicate video content between each other. (*Shaw*; col. 2, ll. 12-24). Thus, the proposed modification would result in a system in which the set-top assembly would be unable to communicate with or control all of the peripheral devices. Thus, the proposed combination would render *Shaw* unsatisfactory for its intended purpose. As a result, there is no motivation or suggestion to make the proposed modification. Accordingly, Applicants respectfully request that the Examiner withdraw the proposed combination as improper.

Even if the proposed combination is not withdrawn, the cited references fail to teach, suggest, or disclose that “the first and second predetermined offsets are usable to determine priority between the first data packet and the second data packet” as recited, in part, in amended Claim 1. The Examiner relies on *Partyka* for the concept of synchronization. In particular, *Partyka* discloses a plurality of nodes that transmit “beacon timing signals at certain varied intervals and varied frequencies.” (*Partyka*; col. 4, ll. 32-34). *Partyka* also discloses the transmission of a data packet during a “transmission opportunity” following the timing signal. (*Partyka*; col. 9, ll. 26-41). There is nothing in *Partyka*, however, that teaches, suggests, or discloses that “the first and second predetermined offsets are usable to determine priority between the first data packet and the second data packet” as recited, in part, in amended Claim 1. *Partyka* makes no mention of “priority” or “priority between the first data packet and the second data packet” as recited, in part, in amended Claim 1. Furthermore, *Partyka* makes no mention of using predetermined offsets “to determine priority” as recited, in part, in amended Claim 1. Because *Partyka* fails to teach, suggest, or disclose these aspects of amended Claim 1, *Partyka* fails to support the rejection. For at least these reasons, Applicants respectfully request reconsideration and allowance of amended Claim 1.

In rejecting Claims 9, 13, and 21, the Examiner employs the same rationale used with respect to Claim 1. Accordingly, for at least the reasons stated with respect to amended Claim 1, Applicants respectfully request reconsideration and allowance of amended Claims 9, 13, and 21.

Claims 2-8, 10-12, 14-20, 22-24, 26, 29-30, 32, and 34 depend from independent claims shown above to be allowable. In addition, these Claims recite further elements not taught, suggested, or disclosed by the cited references. For example, the cited references fail to teach, suggest, or disclose that “the first predetermined offset is usable by the second apparatus to identify the transmit-only apparatus” as recited, in part, in Claim 26. The Examiner relies on *Partyka* for this aspect of Claim 26. In *Partyka*, however, the nodes are not identified based on an offset. Instead, the nodes transmit beacon timing signals, and “the beacon timing signals contain *information that identifies* the transmitting node time-frequency sequence...[and] the time-frequency sequence is determined entirely by *the node identification number*.¹” (*Partyka*; col. 5, ll. 41-51). (Emphases added). Thus, the identification in *Partyka* is not based on an offset but rather on information in the signal. Accordingly, there is nothing in *Partyka* that teaches, suggests, or discloses that “the first predetermined *offset* is usable by the second apparatus to identify the transmit-only apparatus” as recited, in part, in Claim 26. (Emphasis added). Because the cited references fail to teach, suggest, or disclose this aspect of Claim 26, the rejection is improper. For at least these reasons, Applicants respectfully request reconsideration and allowance of Claims 2-8, 10-12, 14-20, 22-24, 26, 29-30, 32, and 34.

The Examiner rejects Claims 25, 28, 33, and 35 under 35 U.S.C. § 103(a) as being unpatentable over *Shaw* in view of *Partyka* and in further view of U.S. Patent Application Publication No. 2002/0089548 A1 to Marler, et al. (“*Marler*”). Claims 25, 28, 33, and 35 depend from independent claims shown above to be allowable. In addition, these claims recite further elements not taught, suggested, or disclosed by the cited references. For at least these reasons, Applicants respectfully request reconsideration and allowance of Claims 25, 28, 33, and 35.

CONCLUSION

Applicants have made an earnest attempt to place this case in condition for allowance. For the foregoing reasons and for other reasons clearly apparent, Applicants respectfully request reconsideration and full allowance of all pending claims.

If there are matters that can be discussed by telephone to further the prosecution of this Application, Applicants invite the Examiner to call the undersigned attorney at (214) 953-6581 at the Examiner's convenience.

Applicants believe no fees are due. However, the Commissioner is hereby authorized to charge any fees or credit any overpayment to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

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